



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/155,327 03/29/99 CORY

S 11686

SCULLY SCOTT MURPHY & PRESSER
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HM22/0802

EXAMINER

KAUSHAL, S

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 08/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/155,327

Applicant(s)
CORY Etal

Examiner
Sumesh Kaushal

Group Art Unit
1633



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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RESTRICTION/ELECTION

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

I - III
II - I
IV - V

Group I, claim(s) 1-5, drawn to an isolated nucleic acid molecule.

Group II, claim(s) 6-10, drawn to an isolated polypeptide.

Group III, claim(s) 11-14, drawn to a method of modulating expression of bcl-w or a derivative thereof in a mammal using an antisense molecule.

Group IV, claim(s) 15-17, drawn to a method of modulating expression of bcl-w or a derivative thereof in a mammal using an antibody..

Group V, claim(s) 18, drawn to a pharmaceutical composition comprising Bcl-W or a derivative thereof or a modulator of Bcl-w activity..

Group VI, claim(s) 19-20, drawn to an antibody.

2. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The isolated nucleic acid, polypeptide and an antibody are distinct from each other because they have different uses. The method of modulating Bcl-w expression by an antisense molecule have different mode of operation than the method of modulating Bcl-W by an antibody. The pharmaceutical composition comprising Bcl-w or modulator of Bcl-W activity

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requires the therapeutic effect of the composition which is distinct from the above mentioned inventions. Thus, inventions are mutually exclusive and are of separate uses.

3. A telephone call was made to Leopold Presser on 7/21/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal whose telephone number is (703) 305-6838.

Sumesh Kaushal
GAU 1633

Scott D. Pribe
SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER